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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/556,440 04/24/00 GJERSET

R INRP:032-2

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HM22/0628

EXAMINER

BRUMBACK, B

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

06/28/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/556,440

Applicant(s)  
Gjerset

Examiner  
Brenda Brumback

Art Unit  
1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 and 18-26, drawn to a method for induction of p53-mediated apoptosis comprising contacting a cell with an inhibitory agent of DNA repair and a stimulatory agent for increasing the level of a tumor suppressor, classified in class 514, subclass 44.
  - II. Claims 1, 10, and 11, drawn to a method for induction of p53-mediated apoptosis comprising contacting a cell with an inhibitory agent that inhibits a protein, classified in class 424, subclass 94.1.
  - III. Claims 1, 10, and 12, drawn to a method for induction of p53-mediated apoptosis comprising contacting a cell with an antisense construct, classified in class 514, subclass 44.
  - IV. Claims 1, 10, 13, and 14, drawn to a method for induction of p53-mediated apoptosis comprising contacting a cell with a retinoid, classified in class 514, subclass 309.
  - V. Claims 1, 10, and 15, drawn to a method for induction of p53-mediated apoptosis comprising contacting a cell with 3-aminobenzamide, classified in class 514, subclass 619.

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VI. Claims 1, 16, and 17, drawn to a method for induction of p53-mediated apoptosis comprising providing a DNA-damaging agent, classified in class 607, subclass 94.

Note: Claims which appear in more than one group will be examined with the elected group to the extent that they read on that group.

2. The inventions are distinct, each from the other because of the following reasons: The methods of Inventions I-VI are directed to different and distinct methods with different method steps and utilizing different and distinct components.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Claim 3 is generic to a plurality of disclosed patentably distinct species comprising p53, p21, and MSH-2. If Invention I is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claim 10 is generic to a plurality of disclosed patentably distinct species comprising c-jun, c-fos, poly-ADP ribose polymerase, DNA polymerase  $\beta$ , topoisomerase I, d-TMP synthase, hMTII-A, uracil DNA glycosylase, alkyl-N-purine DNA glycosylase, DNA ligase IV, DNA ligase III, Hap-1, Ref-1, poly-ADP ribose polymerase, and DNA-dependent protein kinase. If either

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Invention II or Invention III is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claim 11 is generic to a plurality of disclosed patentably distinct species comprising competitors of c-jun, c-fos, poly-ADP ribose polymerase, DNA polymerase  $\beta$ , topoisomerase I, d-TMP synthase, hMTII-A, uracil DNA glycosylase, alkyl-N-purine DNA glycosylase, DNA ligase IV, DNA ligase III, Hap-1, Ref-1, poly-ADP ribose polymerase, and DNA-dependent protein kinase. If Invention II is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claim 12 is generic to a plurality of disclosed patentably distinct species comprising antisense constructs encoding c-jun, c-fos, poly-ADP ribose polymerase, DNA polymerase  $\beta$ , topoisomerase I, d-TMP synthase, hMTII-A, uracil DNA glycosylase, alkyl-N-purine DNA glycosylase, DNA ligase IV, DNA ligase III, Hap-1, Ref-1, poly-ADP ribose polymerase, and DNA-dependent protein kinase. If Invention III is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


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5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1642 FAX telephone number is (703)-305-3014. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

BB

June 27, 2001

  
Brenda Brumback,  
Patent Examiner